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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

JDATO.001DV1RC1

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on May 24, 2006

Signature

Typed or printed name Robert F. Gazdzinski

Application Number

10/680,938

Filed

10/07/2003

First Named Inventor

Kim J. Dato, et al/

Art Unit

3654

Examiner

Haugland, Scott

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Date \_\_\_\_\_

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

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DATO.001DV1RC1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kim J. Dato, et al.

Appl. No.: 10/680,938

Filing Date: October 7, 2003

Examiner: Haugland, Scott J.

Gr. Art Unit: 3654

For: **METHOD AND APPARATUS FOR DISPENSING SPOOLED MATERIAL**

10

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

15 In reply to the Office Action dated February 24, 2006 ("Office Action"), Applicant herein requests a pre-appeal brief review of the above-identified application as follows:

I. CLAIM LIMITATIONS ARE NOT DISCLOSED BY CAYER '929

20 **Claims 28, 39, 40, 44, 45, 51, 58, 59, 60 and 61** – Each of the aforementioned Claims contains language relating to the fact that the ribbon is "pre-curved" or otherwise "curled" prior to being disposed on a spool, etc. For example, Claim 28 sets forth that "*said material comprising material curled by a curling mechanism prior to being disposed on said plurality of spools*"; Claim 39 sets forth "*curled ribbon disposed substantially within said recess...after at least a portion thereof has been curled*"; and Claim 44 sets forth "*ribbon having a curl radius before*  
25 *winding onto said spools*". Each of the remaining Claims 40, 45, 51, 58, 60 and 61 all contain similar language as above.

Applicant submits that the prior art, including Cayer '929 cited by the Examiner, does not in any way teach or suggest any of the aforementioned limitations, and therefore constitutes clear error.

30 The Examiner apparently acknowledges as much, as for at least some of these Claims, the Examiner is apparently utilizing a product-by-process argument in discounting the patentable weight of the above language. For example, the Examiner states that "claim 40 is a product-by-process claim", and that the "article recited in claim 51 is not distinguished over the dispenser of Cayer for similar reasons since the claimed process steps performed in making the article do not  
35 result in an article different from that disclosed by Cayer." The Examiner appears to make similar arguments in support of the rejection of Claims 39, 44, 45, 58 and 59.

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Assuming, *arguendo*, that each of these Claims is properly interpreted as a product-by-process claim, the Examiner's interpretation and application of applicable patent law is, in Applicant's view, clearly incorrect. In determining patentability, product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. See  
5 e.g. MPEP § 2113. In other words, if the same or obviously similar product is available as prior art, one cannot obtain a patent to the prior art product simply because the method of making the product is different.

Therefore, the Examiner must be saying that Cayer '929 discloses the same or obviously similar product as has been claimed by Applicant. **This is clear error.** Applicant has claimed a  
10 dispensing apparatus that dispenses curled ribbon or a curled material. See e.g. the exemplary embodiment of Fig. 9 and its accompanying disclosure. For further clarity, Applicant's website displays several physical embodiments of the invention at <http://www.curlytails.com/>. Cayer '929 teaches at most:

15 *"A dispenser for rolled sheet goods, such as wax paper, aluminum foil, etc., comprises a housing receiving and enclosing a plurality of rolls of sheet goods in vertical orientation, the housing defining a vertical exit slot for each of the rolls of sheet goods, and stop means at the top of the housing which, upon application of pressure, clamps at least a selected*  
20 *one of the rolls of sheet goods against turning."* Abstract of Cayer '929.

Cayer '929, on the other hand, simply does not teach a dispenser for curled ribbon or curled material as has been claimed by Applicant and therefore, even if the Examiner's interpretation of the aforementioned claims as being product-by-process claims is correct, the conclusion that  
25 Cayer '929 and Applicant's invention are the same or obviously similar is erroneous.

## II. CAYER '929 DOES NOT DISCLOSE RIBBON

**Claims 39, 40, 44, 45, 58, 59, 60 and 61** – Each of the aforementioned Claims (i.e.  
30 Claims 39, 40, 44, 45, 58, 59, 60 and 61) recite "ribbon" or "pre-curled ribbon" as an element of each of the Claims. Per page 10 of the Office Action, the Examiner asserts that Cayer '929 discloses "web materials" and that these web materials can "be considered ribbons". Applicant respectfully can find no mention of "web materials" anywhere within Cayer '929. In fact,

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Applicant believes that Cayer '929 only contemplates sheet goods such as wax paper, aluminum foil, self-adhering food wrap (Saran™ wrap), plastic bags (Baggies™ food storage bags), and the like. See e.g. Col. 3, lines 37 – 40 of Cayer '929. Applicant submits that it is clear error by the Examiner to assert that Cayer teaches “ribbon” or “pre-curved ribbon”.

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III. THE EXAMINER’S INTERPRETATION OF THE CLAIMS IS INAPPOSITE TO THE CLAIM LANGUAGE ITSELF

10       **Claims 28, 39, 40, 44, 45, 51, 58, 59, 60 and 61** – Applicant submits that each of the  
aforementioned Claims describes either “curled material” or “curled ribbon”. The Examiner  
appears to repeatedly insist on an interpretation of the term “curled” or “curling” that is  
apparently synonymous with the term “wound” or “winding”. See e.g. Page 3, lines 19 – 22 of  
the Office Action. In other words, the Examiner appears to take the position that winding a  
material or ribbon on a spool inherently imparts curl to the material or ribbon. **Applicant**  
15 **submits that such an interpretation would make the relevant claim language nonsensical**  
**and is therefore not a “broadest reasonable” interpretation.**

For example, Claim 28 sets forth in relevant part that “*said material comprising material*  
*curled by a curling mechanism prior to being disposed on said plurality of spools*”. Under the  
Examiner’s apparent interpretation of the claim language, the spools and the curling mechanism  
20 would apparently be one and the same. And what would be the purpose of curling prior to being  
disposed on the spool(s) if the spools were in fact curling the ribbon?

In Applicant’s view, such an interpretation is an unreasonable interpretation given the  
plain language of the claim itself, and in light of the specification.

Further, Applicant believes that the Examiner’s interpretation is inconsistent with the  
25 language of the claim as evidenced by the following language of Claims 58, 60 and 61, which  
sets forth in relevant part that the *pre-curved ribbon within said dispenser obviates the need for*  
*any curling apparatus on said dispenser*. The Examiner’s interpretation apparently is saying the  
dispenser or at least part of it (i.e., the spool) is the curling apparatus, **an interpretation that**  
**totally ignores the aforementioned claim language which says there is no need for a curling**  
30 **apparatus on said dispenser.**

Applicant respectfully submits that the Examiner’s rejection was improper because it  
ignores relevant claim language, and hence the Examiner’s rejections comprise clear error.

IV. THE EXAMINER'S INHERENCY ARGUMENTS ARE CLEAR ERROR

**Claims 60 and 61** – Claims 60 and 61 set forth a limitation whereby *“the radius of at least one of said spools is selected so as to be substantially the same as the curling radius of said pre-curved ribbon...in a relaxed state”*. The Examiner asserts with respect to Claims 60 and 61 at page 12 of the Office Action, that *“materials (e.g. waxed paper, aluminum foil) disclosed by Cayer do retain curl having substantially the same radius of the spools on which they are unwound or placed in a relaxed state.”* Applicant believes such an assertion is wholly without merit. Applicant has never seen an aluminum foil or waxed paper product which when unspooled or placed in a relaxed state retains a curl of substantially the same radius as the spool onto which it is wound.

The Examiner also provides no evidentiary support for his assertion.

Therefore, the Examiner's assertion is, in Applicant's view, clear error.

V. THE EXAMINER'S INTERPRETATION OF CLAIMS IS INAPPOSITE TO SPECIFICATION

**Claims 28, 39, 40, 44, 45, 51, 58, 59, 60 and 61** – Applicant submits that each of the aforementioned Claims describes either “curled material” or “curled ribbon”. As previously discussed, the Examiner appears to adopt an interpretation of the term “curled” or “curling” that is essentially synonymous with the term “wound” or “winding”. See e.g. Page 3, lines 19 – 22 of the Office Action. Applicant submits this interpretation is clearly inapposite to the plain meaning of the term as would be understood by one of ordinary skill.

It is well settled that during examination, the claims must be interpreted as broadly as their terms reasonably allow, and as is well established, “plain meaning” refers to the meaning given to the term by those of ordinary skill in the art. See e.g. MPEP § 2111.01. In Applicant's view, the Examiner has made clear error in equating “curling” as synonymous with “winding”. As an example of Applicant's use of the term, Applicant sets forth in the specification:

*“In one specific embodiment, the material is decorative ribbon which is passed through a conditioning device to impart curl to the ribbon. Prior to*

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*or during curling, the desired physical properties of the material after conditioning are specified by the user.” page 4, lines 9 – 12.*

5 The rest of the specification is replete with discussion of details on how to implement and use the invention as highlighted in the exemplary embodiment discussed above. In Applicant’s view, the Examiner’s claim interpretation that “*curl*” is synonymous with “*wound*” would render Applicant’s entire specification wholly useless, equating Applicant’s claimed invention to a common spool of wound material. Applicant submits such an interpretation is clear error, as an interpretation which runs completely counter to the underlying concept discussed throughout the  
10 specification can not be considered “reasonable”.

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